

REMARKS

Claims 1-61, all the claims presently pending in the application, stand rejected under 35 U.S.C. 101 because, according to the Office Action, the claimed invention is directed to non-statutory subject matter. Additionally, Claims 1-61 stand rejected on prior art grounds. The specification stands objected to. Claims 2, 3, 5, 10, 19, and 61 stand rejected on informalities. Claims 1-61 are amended herein. Moreover, no new matter is being presented. Applicants respectfully traverse these rejections based on the following discussion.

I. The Objection to the Specification

The abstract is objected to because it is not a single paragraph. As such, Applicants have amended the abstract to place it in proper form. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this objection.

II. The 35 U.S.C. §101 Rejections

Claims 1-61 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. As such, in accordance with the suggestion in the Office Action, Applicants have amended independent claims 1, 20, and 39 to include the element of "generating said redeemable electronic coupons," including means (claim 20) and computer readable program code means (claim 39) for performing the above function, thereby providing a concrete, useful and tangible result. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

III. The Objection to the Claims

Claim 10 is objected to because of informalities. As such, Applicants have amended claim 10 to remove the offending language. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this objection.

IV. The 35 U.S.C. §112, Second Paragraph, Rejection

Claims 2-3, 5, 19, and 61 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. As such, Applicants have amended claims 2-3, 5, 19, and 61 to further clarify and provide proper antecedent basis for the claimed language. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw these rejections.

V. The 35 U.S.C. §103 Rejections

Claims 1-18, 20-37, 39-56 and 58-61 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Freeny, Jr. (U.S. Patent No. 6,513,016), hereinafter referred to as "Freeny" in view of Godin, et al. (U.S. Patent No. 5,890,138), hereinafter referred to as "Godin". Claims 19, 38 and 57 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Freeny, Jr., in view of Godin and Schulze, Jr. (U.S. Patent No. 6,497,360), hereinafter referred to as "Schulze". Applicants respectfully traverse these rejections based on the following discussion.

Freeny teaches an automated product pricing system including a physical store system, a virtual store system, and a control system. The physical and virtual store systems are capable of transmitting sales data indicative of the number of sales of identified respective products. The

control system is adapted to receive the sales data from the physical store system and the virtual store system. In response thereto, the control system generates price change data including a changed price of an identified product based on the sales data received from at least one of the physical and virtual store systems. The price change data is then transmitted by the control system to at least one of the physical and virtual store systems to thereby change the price of the identified product.

Godin teaches an auction system is disclosed which allows users to participate using their own computers suitably connected to the auction system. Preferably, this connection uses the Internet. Godin involves a method and system for providing rapid feedback of a reverse auction process and removes the user from the process once an indication to purchase has been received. Rapid feedback in combination with security of information is achieved with the method and auction system.

Schulze teaches a method and apparatus for accurately collecting and promptly reporting information in connection with the redemption of manufacturer coupons. The method includes the collection of information from a retailer point-of-sale system, and the examination of redeemed coupons. Where matches between product sales, discounts to consumers and redeemed coupons can be made, payment to the retailer of discounts extended to consumers in exchange for manufacturer authorized coupons is immediately made following such verification. In addition, information concerning the redemption of coupons is made available to manufacturers to enable them to adjust promotions to achieve the desired marketing effect. The apparatus may comprise a central processing unit and attached peripherals capable of interfacing with a retailer point-of-sale system and downloading information from the point-of-sale system,

together with secure storage for holding coupons that are to be verified by the apparatus.

The claimed invention, as provided in amended independent claims 1, 20, and 39 contain features, which are patentably distinguishable from the prior art references of record. Specifically, claims 1, 20, and 39 recite, in part, "...wherein said parameters comprise non-quantitative attributes comprising cultural attributes of bidders of said online auctions..." These features are simply not taught or suggested in either Freeny, Godin or Schulze, alone or in combination with one another.

In fact, Freeny says nothing regarding generating market information using parameters associated with bidders of online auctions. In fact, all of the parameters associated with the advertising system in Freeny relate to quantitative data relating to inventory, time spent at the on-line store, amount purchased, and price. For example, col. 11, lines 27-40 of Freeny state, "The owner control system 12 receives sales and inventory data from the physical store systems 14 and/or the virtual store system 18. The sales and inventory data is indicative of product purchases, rate of product purchases and the remaining inventory at the physical store systems 14 and/or the virtual store system 18. Based on the sales and inventory data, the owner control system 12 is programmed to automatically output order data to order products from the product suppliers associated with the product supplier systems 16. The order data can be individualized for each of the physical store systems 14 and/or the virtual store system 18 so that the ordered products are shipped from the suppliers to the correct locations." As such, there is nothing in Freeny that suggests other non-quantitative factors are used to provide targeted advertising or for generating coupons.

Similarly, Godin is also bereft of any language relating to non-quantitative parameters

used in generating market information. As with Freeny, all of the parameters associated with the auction system in Godin relate to quantitative data relating to price, quantity of product available, and time intervals relating to the auction and the goods offered in the auction. For example, step 78 in Figure 2 of Godin suggests that the auction system in Godin gathers personal information. However, col. 4, lines 45-47 in Godin suggest that this personal information only relates to the user's "credit card number and expiry date." Furthermore, col. 7, lines 15-21 in Godin suggest storing user data in a database, whereby the data includes the "user's name and address and E-mail address, as well as credit card information." All of these parameters constitute quantitative parameters. As such, there is nothing in Godin that suggests other non-quantitative factors are used to provide targeted advertising or for generating coupons.

Likewise, Schulze does not teach or suggest using non-quantitative parameters for generating market information. In the coupon system in Schulze, there is no teaching relating any parameters attributed with the consumer's personal information/data to the coupon generation process. In fact, Schulze only very generically describes storing consumer data in the form of consumer identity "in connection with the sale of the product" (see col. 7 line 67 to col. 8 line 7 in Schulze). As such, there is nothing in Schulze that suggests parameters at all, let alone non-quantitative factors, are used to provide targeted advertising or for generating coupons.

Additionally, there is no suggestion in Freeny, Godin, or Schulze how non-quantitative factors could be stored, and most importantly, considered by the respective systems for generating coupons. This is truly a unique feature of the claimed invention, which is able to garner this type of information, store it, process it, and use it for generating coupons. Thus, even if Freeny were combined with Godin or if Freeny were combined with both Godin and Schulze,

it would still fail to teach or suggest to one of ordinary skill in the art how this generation of coupons would occur given an input of non-quantitative parameters.

Furthermore, Freeny in combination with Godin and Schulze and the Examiner's Official Notice is legally unjustified, especially since each of Freeny, Godin, and Schulze take mutually exclusive paths to solve wholly unique solutions, and do not provide motivation for combination with one another. Insofar as references may be combined to teach a particular invention, and the proposed combination of Freeny with Godin, and Freeny with Godin and Schulze, case law establishes that, before any prior-art references may be validly combined for use in a prior-art 35 U.S.C. § 103(a) rejection, the individual references themselves or corresponding prior art must suggest that they be combined.

For example, in In re Sernaker, 217 USPQ 1, 6 (C.A.F.C. 1983), the court stated: "[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings." Furthermore, the court in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 USPQ 2d 1434 (C.A.F.C. 1988), stated, "[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art must suggest the desirability and thus the obviousness of making the combination."

In the present application, the reason given to support the proposed combination is improper, and is not sufficient to selectively and gratuitously substitute parts of one reference for a part of another reference in order to try to meet, but failing nonetheless, the Applicant's novel claimed invention. Furthermore, the claimed invention, as amended, meets the above-cited tests

for obviousness by including embodiments such as using non-quantitative parameters for obtaining market information. As such, all of the claims of this application are, therefore, clearly in condition for allowance, and it is respectfully requested that the Examiner pass these claims to allowance and issue.

As declared by the Federal Circuit:

In proceedings before the U.S. Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Fritch, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) citing In re Fine, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988).

Here, the Examiner has not met the burden of establishing a prima facie case of obviousness. It is clear that, not only does Freeny fail to disclose all of the elements of the claims of the present invention, particularly, the non-quantitative parameters for obtaining market information such as cultural demographics, as discussed above, but also, if combined with Godin and/or Godin with Schulze, fails to disclose these elements as well. The unique elements of the claimed invention are clearly an advance over the prior art.

The Federal Circuit also went on to state:

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. . . . Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Fritch at 1784-85, citing In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Here, there is no suggestion that Freeny, alone or in combination with Godin or with Godin and Schulze teaches a method and apparatus containing all of the limitations of the claimed invention. Consequently, there is absent the "suggestion" or "objective teaching" that would have to be made before there could be established the legally requisite "prima facie case of obviousness."

In view of the foregoing, the Applicants respectfully submit that the cited prior art references do not teach or suggest the features defined by amended independent claims 1, 20, and 39 and as such, claims 1, 20, and 39 are patentable over Freeny alone or in combination with Godin or with Godin and Schulze or with the purported teachings provided as Official Notice. Further, dependent claims 2-19, 21-38, and 40-61 are similarly patentable over Freeny alone or in combination with Godin or with Godin and Schulze or with the purported teachings provided as Official Notice, not only by virtue of their dependency from patentable independent claims, respectively, but also by virtue of the additional features of the invention they define. Thus, the Applicants respectfully request that these rejections be reconsidered and withdrawn.

Moreover, the Applicants note that all claims are properly supported in the specification and accompanying drawings, and no new matter is being added. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections.

VI. Formal Matters and Conclusion

With respect to the objection to the abstract, the abstract has been amended, above, to overcome this objection. With respect to the objections and rejections to the claims, the claims have been amended, above, to overcome these objections and rejections. In view of the

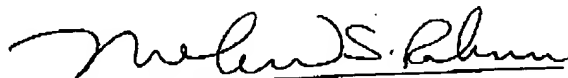
foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections to the claims.

In view of the foregoing, Applicants submit that claims 1-61, all the claims presently pending in the application, are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary. Please charge any deficiencies and credit any overpayments to Attorney's Deposit Account Number 09-0441.

Respectfully submitted,

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Mohammad S. Rahman
Reg. No. 43,029
McGinn & Gibb, P.L.L.C.
2568-A Riva Road, Suite 304
Annapolis, MD 21401
Voice: (301) 261-8625
Fax: (301) 261-8825
Customer Number: 29154